



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/500,132	02/08/2000	Kiyoshi Iseki	11197/1	2161
7590	01/03/2007		EXAMINER	
John C. Altmiller Kenyon & Kenyon 1500 K Street N.W. Suite 700 Washington, DC 20005-1257			CHEVALIER, ALICIA ANN	
			ART UNIT	PAPER NUMBER
			1772	
SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE		
3 MONTHS	01/03/2007	PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/500,132	ISEKI ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Alicia Chevalier	1772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 02 October 2006.

2a)  This action is **FINAL**.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## **Disposition of Claims**

4)  Claim(s) 1-3 and 20-23 is/are pending in the application.  
4a) Of the above claim(s) 20 is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1-3 and 21-23 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO/SB/08)  
    Paper No(s)/Mail Date \_\_\_\_\_.  
4)  Interview Summary (PTO-413)  
    Paper No(s)/Mail Date. \_\_\_\_\_.  
5)  Notice of Informal Patent Application  
6)  Other: \_\_\_\_\_.  
\_\_\_\_\_

## **RESPONSE TO AMENDMENT**

### ***Request for Continued Examination***

1. The Request for Continued Examination (RCE) under 37 CFR 1.53 (d) filed on October 2, 2006 is acceptable and a RCE has been established. An action on the RCE follows.
2. Claims 1-3 and 20-23 are pending in the application, claim 20 is withdrawn from consideration. Claims 4-19 have been cancelled.
3. Amendments to the claims filed on August 2, 2006 have been entered in the above-identified application.

### ***WITHDRAWN REJECTIONS***

4. The 35 U.S.C. §103 rejections made of record in the office action mailed February 2, 2006, pages 2-7, paragraphs #2-4 has been withdrawn due to Applicant's amendment in the response filed August 2, 2006.

### ***REJECTIONS***

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

***Claim Rejections - 35 USC § 112***

6. Claims 1-3 and 21-23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The limitation “the controlled maximum thickness of the inorganic oxide layer of the portion of the film is equal to or less than 1.5 times the controlled minimum thickness of the inorganic oxide layer of the portion of the film among layer thickness values measured along the length and the width in the portion of the film” in claim 1 is unclear which renders the claim vague and indefinite. It is unclear whether Applicant is claiming a thickness range or the variation of thickness through the film, e.g. film evenness.

The limitation “wherein the difference between a maximum wt% and a minimum weight of the one component of the composite oxide in said one roll unit of the plastic film is within 20 wt,” in claim 2 is unclear which renders the claim vague and indefinite. It is unclear whether Applicant is claiming a thickness range or the distribution of the one component through out the film, e.g. the concentration variation of the one component.

***Claim Rejections - 35 USC § 103***

7. Claims 1-3 and 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Masuda et al. (U.S. Patent No. 5,529,832) in view of Kobayashi et al. (U.S. Patent No. 3,676,612).

Regarding Applicant's claims 1 and 23, Masuda discloses a polyester film (*title*) used as a base film for magnetic recording media such as video tape, an audio tape, a computer tape and a floppy disk (*col. 1, lines 18-21*).

Masuda also discloses a functional roll film comprising a plastic film (*polyester film, title*) and an inorganic oxide layer on at least one surface (*col. 5, lines 15-19*). Furthermore, it is noted that Masuda discloses that the laminated polyester film of the invention is formed from at least two layers (*col. 4, lines 56-57*) and that at least one of the layers incorporates inert inorganic particles (*col. 5, lines 15-19*). Therefore, one of the layers of is considered the plastic film layer and the other layer with inorganic particles is considered to be the inorganic oxide layer. The plastic film is deemed to have gas barrier properties, since all articles will have gas barrier properties. The one roll unit of the plastic film has a width of at least 400 mm and a length of at least 4,000 m (*col. 10, lines 60-61*). Also, the controlled maximum thickness of the inorganic oxide layer of the portion of the film is equal to or less than 1.5 times the controlled minimum thickness of the inorganic oxide layer of the portion of the film among layer thickness values measured along the length and the width in the portion of the film (*col. 8, lines 22-26 and/or table 1*). The static electricity of the plastic film with the inorganic oxide layer is deemed to be in the range from -10 kV to +10kV, since Masuda discloses the same plastic film, i.e. polyester such as polyethylene terephthalate, and inorganic material, i.e. silicon dioxide, as disclosed in Applicant's specification.

Masuda fails to disclose that the plastic film is transparent.

Kobayashi discloses magnetic tape, i.e. magnetic recording media, (*title*) comprising a transparent polyester resin, such as polyethylene terephthalate, while the magnetic coating is

formed from a black material. Therefore, a heater of the kind emitting energy which is absorbed by the black material but which is transmitted through the transparent base may be selected so as thereby to eliminate the need for applying heat solely to the magnetic surface and permit the application of heat to the opposite surfaces of the tape (*col. 4, line 74 through col. 5, line 8*).

Masuda and Kobayashi are analogous because they both disclose polyester base layers for magnetic recording media.

It would have been obvious to one of ordinary skill in the art at the time of the invention to make Masuda's polyester film transparent as taught by Kobayashi in order to permit the application of heat to the both surfaces of the tape.

The limitation "is cut" is a method limitation and does not determine the patentability of the product, unless the process produces unexpected results. The method of forming the product is not germane to the issue of patentability of the product itself, unless Applicant presents evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. MPEP 2113. Furthermore, there does not appear to be a difference between the prior art structure and the structure resulting from the claimed method because the combination of Masuda and Kobayashi discloses a roll unit of the plastic film with a portion of the film having a width of at least 400 mm and a length of at least 4,00 m.

Regarding Applicant's claim 2, Masuda discloses wherein the inorganic oxide layer comprises a composite oxide having at least components (*col. 5, lines 46-50*). Masuda also discloses wherein the difference between a maximum wt% and a minimum weight of the one component of the composite oxide in said one roll unit of the plastic film is within 20 wt (*col. 5, line 51-59*). In the alternative that the difference of the one component is a concentration

Art Unit: 1772

variation of the one component, the exact difference between the maximum wt% and minimum weight of the one component is deemed to be a result effective variable with regard to the evenness of the film. It would require routine experimentation to determine the optimum value of a result effective variable, such as exact difference between the maximum wt% and minimum weight of the one component, in the absence of a showing of criticality in the claimed exact difference between the maximum wt% and minimum weight of the one component. *In re Boesch*, 205 USPQ 215 (CCPA 1980), *In re Woodruff*, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990). One of ordinary skill in the art would have been motivated to have the difference between a maximum wt% and a minimum weight of the one component of the composite oxide in said one roll unit of the plastic film is within 20 wt in order to increase the evenness of the sheet (*table 1*).

Regarding Applicant's claims 3 and 21, Masuda discloses that the one roll unit of the plastic film has a width of at least 1,000 mm and a length of at least 15,000m (*col. 10, lines 60-61*).

Regarding Applicant's claim 22, Masuda fails to that the one roll unit of the plastic film has a width of 400 to 1000 mm and a length of 4,000 to 10,000 m. However, Masuda does disclose that the one roll unit of the plastic film has a width of 1,100 mm and a length of 15,000 m (*col. 10, lines 60-61*). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to make the one roll unit of the plastic film has a width of 400 to 1000 mm and a length of 4,000 to 10,000 m, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art in the absence of showing unexpected results. MPEP 2144.05 (II).

***ANSWERS TO APPLICANT'S ARGUMENTS***

8. Applicant's arguments in the response filed August 2, 2006 regarding the previous rejections of record have been considered but are moot since the rejections have been withdrawn.
9. Applicant's arguments in Declaration filed August 2, 2006 of record have been carefully considered but is moot since the rejection based on Matsuda has been withdrawn.

***Conclusion***

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia Chevalier whose telephone number is (571) 272-1490. The examiner can normally be reached on Monday through Friday from 8:00 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon, can be reached on (571) 272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ac  
12/22/06

  
ALICIA CHEVALIER  
PRIMARY EXAMINER